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1   RECORD OF ORAL HEARING

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3   UNITED STATES PATENT AND TRADEMARK OFFICE

4   _____

5

6   BEFORE THE BOARD OF PATENT APPEALS

7   AND INTERFERENCES

8   _____

9

10   Ex parte GEOFFREY FLAGSTAD

11   _____

12   Appeal 2009-005845

13   Application 10/679,749

14   Technology Center 3600

15   _____

16   Oral Hearing Held: November 5, 2009

17   _____

18 Before KENNETH W. HAIRSTON, HUBERT C. LORIN, and ANTON W.

19 FETTING, *Administrative Patent Judges.*

20

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22 APPEARANCES:

23

24 ON BEHALF OF THE APPELLANT:

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31   The above-entitled matter came on for hearing Thursday, November

32 5, 2009, commencing at 9:39a.m., at the U.S. Patent and Trademark Office,

33 600 Dulany Street, Alexandria, Virginia, before Victor Lindsay, a Notary

34 Public.

1	P R O C E E D I N G S
2	
3	THE USHER: Good morning, Calendar No. 31, Mr. Wheeler.
4	JUDGE HAIRSTON: Okay. Thank you.
5	THE USHER: You're welcome.
6	JUDGE HAIRSTON: Good morning, counsel.
7	MR. WHEELER: Good morning. I'll just set up real quickly.
8	JUDGE HAIRSTON: Okay.
9	MR. WHEELER: Good morning.
10	JUDGE HAIRSTON: Good morning.
11	MR. WHEELER: I'm here on Appeal 2009-005845, just to make
12	sure we're all on the same page, and what I want to cover if I have time, and
13	I'm never sure if I have time, is four or five points. First of all, I just want to
14	-- as a housekeeping issue, I just to make sure that everybody knows that the
15	101 issue is not here anymore.
16	JUDGE HAIRSTON: Right.
17	MR. WHEELER: It's been withdrawn by the Examiner, so we don't
18	have to worry about that.
19	And the next thing I want to talk about a little bit is the invention and
20	basically what's so special about not processing data. After that, to the
21	extent time permits, I'm going to talk a little bit about Joao reference, I
22	believe that's the pronunciation, and Segal. These two references are 100
23	percent data processing, and the Examiner tried to argue otherwise, but I
24	don't think his arguments were good and I can explain why.

1   And then finally, because the Examiner realized, I think, that he didn't

2 have the priority needed, he went to official notice, and he didn't establish it

3 correctly. He didn't accept the traverse, and so it shouldn't stand.

4   JUDGE LORIN: All right, counsel. I want to cut to the chase here.

5   MR. WHEELER: Sure.

6   JUDGE LORIN: We're familiar with the record and the Brief.

7   MR. WHEELER: Sure.

8   JUDGE LORIN: And your major argument in the Brief, and you

9 raise it numerous times, is that you have this limitation, this clause, in this

10 claim, "without data processing said medical record."

11   MR. WHEELER: Right.

12   JUDGE LORIN: This was introduced as an amendment to the claims,

13 correct, during prosecution?

14   MR. WHEELER: Yes. I think in all cases, yes.

15   JUDGE LORIN: I have not been able to find this in the specification.

16   MR. WHEELER: Okay.

17   JUDGE LORIN: I'm not really even really sure what you mean by

18 this. Is there any discussion of this in your specification?

19   MR. WHEELER: Okay. I can't see I'm prepared for that issue, but let

20 me take a look here.

21   JUDGE LORIN: The reason I bring it up is because your Appeal

22 Brief makes the point that you're doing something different to the data than

23 the prior art.

24   MR. WHEELER: Right, right.

25   JUDGE LORIN: And that difference is that you do not process the

26 data.

1   MR. WHEELER: Right.

2   JUDGE LORIN: What do you mean that you do not process the data

3 and the prior art does?

4   MR. WHEELER: Okay. It largely comes down to who processes the

5 data, and the reason I say that is because we don't say no data is processed at

6 all. We say -- and I should turn to the claim here.

7   JUDGE LORIN: Your claim says "Without data processing said

8 medical record."

9   MR. WHEELER: Okay. It's "the following steps carried out by a

10 service provider that is not the patient or recovered entity," and then we have

11 "without data processing." So it's a service provider. In other words, this

12 isn't the doctor, this isn't the patient. This is somebody else that's helping the

13 patient.

14   And I might point out that we then, in claim, for example, 2, we

15 induce the patient to convert the record to a storage format, which is data

16 processing. Conversion of a record, you know, processing it and changing it

17 to a different format, that kind of thing.

18   So it's not that nobody will ever data process anything, because that

19 would be impossible. Because if -- the problem is a voluminous record and

20 something way down in the middle is, you know, needed, but it's way down

21 in the middle.

22   My point of view is if you're data processing -- data is just

23 information; processing is organizing, sorting -- even if you took that middle

24 piece, put it on the top, underlined it, highlighted it, you know, so it would

25 be present for the doctor to see immediately, I think that would probably be

26 data processing. So this is done without the service provider data processing

1   it. It relies on the patient, essentially, to process the data and helping the

2   patient do that.

3   JUDGE LORIN: That wasn't the distinction I saw in the Brief. Are

4   you arguing that -- because I see this clause.

5   MR. WHEELER: Right.

6   JUDGE LORIN: It's repeated four times in the claim after each of

7   these steps.

8   MR. WHEELER: Right.

9   JUDGE LORIN: Are you meaning to say that it's the service provider

10 who is not processing the medical records?

11   MR. WHEELER: Yes, that's what I mean.

12   JUDGE LORIN: That's what you mean to say?

13   MR. WHEELER: Yes.

14   JUDGE LORIN: You're not meaning to say that these records are not

15 processed?

16   MR. WHEELER: By anybody, right. We do get into the Brief,

17 perhaps indirectly, by referring to particular limitations, you know, this

18 limitation, and we do have some discussion, I think, of the service provider,

19 you know, who the service provider is and that kind of thing. But you may

20 be right that there may not be a direct statement that, you know, this is

21 what's going on.

22   JUDGE LORIN: Okay. So, let me see if I understand, because

23 this -- the way I read this claim is you have inducing, receiving a record,

24 storing the record, obtaining an agreement and transmitting the record.

25   MR. WHEELER: Right.

1   JUDGE LORIN: And this can be done conventionally, as long as it's

2   being done by the service provider?

3   MR. WHEELER: Well, by conventionally, I think you mean without

4   computers, that kind of thing, or --

5   JUDGE LORIN: Well, in your Brief, you stated that you agreed with

6   the Examiner.

7   You said here, on page 25 of your Brief, the Applicant agrees, you

8   know, step B, receiving -- you know, that a patient could scan her own

9   medical record to a PDF, store it on a CD and hand the CD to a service

10   provider.

11   MR. WHEELER: Right.

12   JUDGE LORIN: I read that, but I had a difficulty understanding what

13   the difference is.

14   MR. WHEELER: Well, remember who's doing it. We're talking

15   about the patient doing it. In other words, the patient has always been

16   able -- you know, you're entitled to get your own medical records. So, you

17   get your medical records and you hand them off to some other doctor.

18   You've always been able to do that. But nobody has been able to -- what the

19   service provider basically does is he enables the patient to do more than just

20   hand off the records, to turn the record into a format that, for example, an

21   emergency doctor can use, you know, in a few seconds, to find the little

22   nugget he needs. You've always been able to, you know, take the records

23   involved, or, you know, any part of them, or whatever you're doing, and

24   transmit them to somebody else if you are the patient.

25   JUDGE LORIN: Right.

1   MR. WHEELER: But that's not the invention. The invention is a

2 service provider being able to assist you in this process, to lead you to a

3 better medical record.

4   JUDGE LORIN: So, rather than the patient doing this, the patient

5 hands it off to a service provider.

6   MR. WHEELER: Right.

7   JUDGE LORIN: He does it for the patient.

8   MR. WHEELER: And that's how the claim is limited, right.

9   JUDGE LORIN: Now, what do you mean by service provider? I

10 couldn't find the definition in your specification for that.

11   MR. WHEELER: Well, I think it's as much defined by the claim as

12 anything else. The claim says the service provider -- let me turn to the claim

13 language -- a service provider -- no, that's not it -- up in the preamble, "A

14 service provider that is not the patient or a covered entity." A covered entity

15 is a defined term in HIPA, and that's the doctors and people who process

16 medical records.

17   JUDGE LORIN: So, would a service provider be, for instance, a

18 guardian? Say the patient is a child.

19   MR. WHEELER: Right, okay.

20   JUDGE LORIN: Could the service provider be the parent of the

21 child?

22   MR. WHEELER: Well, the parent of the child is in a relationship

23 legally of having to -- being able to speak for the child, so it's just -- the

24 child is speaking through the parent, if you will, something like that.

25   JUDGE LORIN: But the parent is not the patient and not a covered

26 entity.

1   MR. WHEELER: Right, right. Well, if the parent is doing all these

2   steps without data processing that kind of defeats it, because if they do it

3   without data processing, they're just bringing the big stack over to the doctor

4   and not focusing it. So it wouldn't be very useful to that person. But that

5   person, you're right, is not a covered entity and that person is not the patient,

6   depending on, you know, how you want to argue about guardianship and so

7   forth.

8   JUDGE LORIN: All right, counsel, thank you.

9   MR. WHEELER: Okay. Why don't I just pick up with the arguments

10   on judicial notice. The Examiner depends on judicial notice, I believe it's in

11   every rejection, and if you look at the judicial notice that the Examiner

12   stands on, the Examiner hasn't done it correctly. And, to get to more details,

13   first of all, the particular question -- this is step E of claim one -- so it's

14   transmitting the medical record to a third party when defining -- conditions

15   have occurred, you know, for example, they agree that they'll do it under

16   certain circumstances, like if I'm unconscious, they'll send my records,

17   without data processing the medical record.

18   The first thing is, the Examiner did not establish, nor is it a fact, that

19   transmitting the records without data processing is a fact that could be

20   instantly and unquestionably demonstrated as well known. The very reason

21   the Examiner really relied on official notice is because he had references.

22   He had the Joao reference and he had the Segal reference, but these

23   references did not make evident that this information was well known. And

24   so that's the first thing. And the Examiner really didn't -- has never

25   responded to this.

8

1   The second point is that official notice is the principal basis of the

2   rejection. We're not just filling in on a little slot, you know, proving the sun

3   sets in the west, without having to find a particular reference, or, for

4   example, you know, if we refer to a computer, does that refer to data

5   processing, or something like that. The Examiner relies on it to define the

6   point of novelty. I think the point of novelty, fairly said, is without data

7   processing, doing certain things -- the service provider doing certain things

8   without data processing. That's the point of novelty. All the Examiner has

9   on this particular point of novelty, claim 1-E, is official notice. We argue

10   this on page 28 of the Brief. Again, the Examiner didn't respond to that.

11   Furthermore, the way in which official notice was taken was not

12   proper. It was taken without providing any support or reasoning for the

13   conclusion that without data processing it's common knowledge. If you go

14   to the -- in the Examiner's Answer -- I believe this is on page 6 of the

15   Examiner's Answer, and I don't know if I need to go through it, but

16   basically, there's a part 6 where he says official notice was taken of basically

17   claim 1-E, and then it says refer to 5. Refer to 5, 5 doesn't talk about

18   anything about data processing. There's just nothing there, and that, of

19   course, is the basis on which we traversed official notice, is that, you know,

20   you can't unquestionably demonstrate that without data processing -- that

21   he's doing this step without data processing is well known.

22   JUDGE LORIN: Well, yeah. I mean it's true, in the answer on pages

23   5 and 6. But I think the Examiner is just making a broad point that

24   transmitting a medical record to another party is well known.

25   MR. WHEELER: Yeah, merely transmitting them, sure.

1   JUDGE LORIN: Right. I think that's what the Examiner is trying to

2   say.

3   MR. WHEELER: Right. But he needs prior art for doing it without

4   data process, you know. You can't just say, well, you know, we're ignoring

5   that part, or we're taking official notice, which is fundamentally the same

6   thing, just saying it's just well known and I'm not going to bother with it.

7   JUDGE LORIN: Yeah. I mean this goes back to your major

8   argument that the prior art doesn't show the service provider, for example,

9   doing this last step without data processing.

10   MR. WHEELER: Exactly.

11   JUDGE LORIN: Right.

12   MR. WHEELER: But the Examiner said that he didn't have the prior

13   art and -- for 1-E, but then he relied on official notice.

14   JUDGE LORIN: Yeah, but I don't think the Examiner is really

15   pointing to a distinction on the service provider.

16   MR. WHEELER: Okay.

17   JUDGE LORIN: You know, that's the distinction you're making now.

18   MR. WHEELER: Right, yeah. He did have an argument based on

19   Segal that was not the service provider doing something, right.

20   JUDGE LORIN: Yeah. There seemed to be a debate between the two

21   of you on whether data processing was occurring.

22   MR. WHEELER: Right.

23   JUDGE LORIN: But now I understand you a little more clearly to

24   say it's not so much the data processing that's the issue here. It's who's doing

25   the data processing.

26   MR. WHEELER: Right, right.

1   JUDGE LORIN: Right, but that's not --

2   MR. WHEELER: Because you want the patient to do it, but nobody

3 else can, basically.

4   JUDGE LORIN: Right, right.

5   MR. WHEELER: Right.

6   JUDGE LORIN: But all I'm saying is when the Examiner was

7 applying the official notice, it wasn't really to make the point that it was well

8 known for the service provider not to do that. All the Examiner is saying is

9 that your steps of receiving a medical record, of transmitting it, those steps,

10 per se, are well known.

11   MR. WHEELER: Right, just taken by themselves.

12   JUDGE LORIN: Are you disputing that? Are you disputing that just

13 the steps of transmitting --

14   MR. WHEELER: No. I'm not disputing that. I think what I'm

15 disputing then is that the official notice covers the problem for the Examiner.

16 In other words that the Examiner has something to cover all the elements of

17 the claim. Because if official notice doesn't cover, you know, the service

18 provider transmitting the records without data processing, and the Examiner

19 doesn't have prior art on that, you know, there's nothing left.

20   JUDGE LORIN: Yeah. Well, that's the point you're making in your

21 Brief.

22   MR. WHEELER: Right, sure.

23   JUDGE LORIN: Yeah, sure. I understand.

24   MR. WHEELER: Okay. Okay. I'm not sure if I have any time

25 remaining, so --

1   JUDGE HAIRSTON: Well, sum up what -- you had some other point

2   to make?

3   MR. WHEELER: Well, I don't think I really need to sum up very

4   much. I mean, I think we've pretty much been over it.

5   JUDGE HAIRSTON: Okay.

6   MR. WHEELER: I think the summary is what I said in the beginning.

7   It's basically that the prior art that was cited, the Joao and Segal references,

8   are all about data processing, and we argued that in the Brief, of course.

9   And I think that it's important that the official notice was essential,

10 and if the official notice is limited, as you have pointed out it may have

11 been, the Examiner didn't have a prima facie case because the Examiner

12 hadn't found all the elements in the prior art or, you know, effectively in the

13 prior art.

14   So, and the final point -- I guess the final point -- one final point I

15 want to make is that we do have separately-argued claims where there is data

16 processing going on: claim 2, claim 19, and some others. And so that's

17 another thing that the prior art really doesn't show, and particularly, in

18 combination with the other elements.

19   JUDGE HAIRSTON: Okay. Any other questions?

20   Okay. Thank you, counsel.

21   MR. WHEELER: Thank you.

22   (Whereupon, the proceedings, at 9:58 a.m., were concluded.)